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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q65170

Nobufumi MORI, et al.

Appln. No.: 09/887,334

Group Art Unit: 2854

Confirmation No.: 5953

Examiner: Stephen R. FUNK

Filed: June 25, 2001

For: PLANOGRAPHIC PRINTING PRESS

REQUEST FOR ORAL HEARING

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Appellants hereby request an Oral Hearing in the above-identified application before the Patent and Trademark Office Board of Patent Appeals and Interferences.

A check in the amount of \$290.00 for requesting an Oral Hearing is attached. The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account. A duplicate copy of this sheet is attached.

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Respectfully submitted,

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WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: May 7, 2004



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REPLY BRIEF PURSUANT TO 37 C.F.R. § 1.193(b)

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 1.193(b), Appellants respectfully submit this Reply Brief in response to the Examiner's Answer dated March 15, 2004. Entry of this Reply Brief is respectfully requested.

POINTS RAISED IN EXAMINER'S ANSWER

The Examiner's Answer raises issues regarding Appellant's "Arguments" (Section VIII.) set forth in the Appeal Brief. Appellant addresses the issues raised by the Examiner below.

In the second and third paragraphs on page 4 of the Examiner's Answer, the Examiner maintains there is no structural or functional difference in a means for heating, i.e., whether it is arbitrarily activated simultaneously with a light irradiation section or whether it is activated

sequentially before a light irradiation section. Further, the Examiner maintains that claim 13 does not necessarily have to be interpreted such that the heating is performed *during* light irradiation.

The Examiner's interpretation, however, appears to improperly truncate the entire function of the claimed means. *See Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931, 938, 4 USPQ2d 1737 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 961 (1988). Claim 13 does not merely recite a "means for heating". Rather, claim 13 recites a "means for heating said original plate during irradiating said activation light so that the temperature of the surface of said original plate becomes 40 through 200°C one of as per image and on the entire surface thereof, so that a hydrophobic area and a hydrophilic area are formed on said original plate." (emphasis added). Appellant submits that the entire means recitation, i.e., the means **plus** function, of claim 13, must be given patentable weight under 35 U.S.C. § 112, sixth paragraph.

The Examiner additionally argues that whether or not 35 U.S.C. § 112, sixth paragraph applies, it is improper to limit an apparatus claim by the time when two separate elements are activated (i.e. a part of their function) (pg. 4, fourth paragraph of Examiner's Answer). Such statement, however, is contrary to 35 U.S.C. § 112, sixth paragraph, which sets forth that the prior art must perform the identical function specified in the claim. Further, as noted in the non-limiting embodiment disclosed on page 12, lines 9-12 of the present Application, a fast depicting rate is secured by controlling the original plate temperature when irradiating activation light (i.e. the function of heating during irradiation of the activation light, as recited in claim 13).

On pg. 5 of the Examiner's Answer, the Examiner indicates confusion in regard to specific arguments, set forth on pg. 7 of the Appeal Brief, which relate to Fig. 2 of the present Application. However, the arguments and references to Fig. 2 are made in direct response to the Examiner's statements presented on the Continuation Sheet of the October 14, 2003 Advisory Action (i.e. Appeal Brief, paragraph beginning on pg. 5 and ending on pg. 6). Nevertheless, as acknowledged by the Examiner, Appellant clearly asserts that Fig. 2 of the present Application is a non-limiting embodiment of the invention, and as such, does not comprise the only embodiment encompassed by claim 13 (pg. 5 of Examiner's Answer). For example, additional non-limiting embodiments of the claimed heating means, i.e., elements 58 and 59, are shown in Figs. 4 and 5 of the present Application.

CONCLUSION

For the above reasons as well as the reasons set forth in Appellant's Brief on Appeal, Appellants respectfully request that the Board reverse the Examiner's rejections of all claims on Appeal. An early and favorable decision on the merits of this Appeal is respectfully requested.

Respectfully submitted,



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